

REMARKS

This is in response to the initial Office Action, mailed June 16, 2004, in relation to the above-identified patent application, and following a telephonic interview with the Examiner on September 1, 2004, wherein agreement was reached regarding claim amendments. In that Office Action, the Examiner rejected Claims 1-9. In particular, Claims 1-9 were rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. The Examiner also rejected Claims 1-8 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,686,021, issuing to Main ("MAIN"), and Claims 1-3 and 6-8 as being anticipated by U.S. Patent No. 1,323,927 issuing to Taylor ("TAYLOR"). Finally, the Examiner rejected Claim 9 under 35 U.S.C. § 102(a) as being unpatentable over MAIN or TAYLOR in light of U.S. Patent No. 886,170 issuing to Avansino ("AVANSINO").

In this response, Applicant has cancelled Claims 2-4, 6, 7 and 9, added Claims 10-12, and amended Claims 1, 5, and 8 to increase the readability of the application, and, to comply with 35 U.S.C. § 112, to more particularly point out and distinctly claim the subject matter of the present invention. Independent Claim 1 has been amended to overcome the rejection based upon 35 U.S.C. § 102(b).

As such, Claims 1, 5, 8, and 10-12 remain pending in the application. Applicant respectfully requests reconsideration of the present application and the allowance of Claims 1, 5, 8, and 10-12.

Statement of Telephonic Interview

The undersigned completed a telephonic interview with the Examiner on September 1, 2004. Prior to that interview, the Examiner was provided a copy of an earlier version of the office action including the above claim amendments. The Examiner stated that the amendments to Claim 1 overcomes the cited 35 U.S.C. § 112 rejections and the 35 USC § 102(b) rejection based upon MAIN. The Examiner also stated that if either the limitations of claims 4, 5 or 8 were incorporated into Independent Claim 1, they would overcome the cited 35 USC § 102(b) rejection based upon TAYLOR.

Claim Rejections Under 35 U.S.C. § 112

In the Office Action, the Examiner rejected Claims 1-9 under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 has been amended in response to this rejection.

In particular, in his comments about Claim 1, the Examiner indicated that there was insufficient antecedent basis for the terms “the inside” and “said pivot pin.” Thus, this claim has been amended to provide a proper antecedent basis for these respective elements.

Claim Rejections Under 35 U.S.C. § 102(b)

In the Office Action, the Examiner rejected Claims 1-8 under 35 USC § 102(b) as being anticipated by MAIN, and Claims 1-3 and 6-8 as being anticipated by TAYLOR. Applicant has amended Independent Claim 1 to more clearly point out the novel features of the present invention and to distinguish those features over MAIN and TAYLOR, and has added new

Independent Claims 10-12.

MAIN discloses a tool for splitting a tire rim, comprising: a central bar member (19) having a proximal and distal end; two separate arms (21, 23) pivotally mounted on a distal end of the central bar for engagement with a workpiece; wherein each arm has a pivot point which is positioned a given distance apart from the other to establish a camming action; and wherein the central bar member (19) is swung in a clockwise or counter-clockwise motion to create a rotational force.

TAYLOR discloses a similar tool for splitting a tire rim, comprising: a central bar member (7) having a proximal and distal end; two arms (16, 17) having hooks (14, 15) at one end for engaging the rim (23) and pivotally connected at the other ends (18); wherein the hooks (14,15) securely anchor to the rim (23) at two points, and upon swinging the lever in a direction to draw the hook (10) inward.

Claim 1 has been amended to include the words “adapted for use in a confined area of a workpiece enclosure,” and to more particularly point out that the “engagement arm and pressure arm having the same pivot point” and “move apart from one another in the confined area of the workpiece enclosure when a linear directional force is applied to said central bar.” Support for these amendments may be found in the illustrations of Figures 1-3. New Independent Claims 10-12 also include these limitations.

With respect to Claim 1, MAIN does not disclose the adaption of a tool for use in a confined or hard-to-reach area or environment. Instead, the tool in MAIN requires that the workpiece (tire rim) be unobstructed and easily accessible to the user's hands. Further, MAIN

does not disclose a tool having two separate arms which share the same pivot point. In fact, the very purpose of the invention in MAIN is to provide mechanical advantage through the use of separate pivot points distanced from one another to create a camming effect. Finally, MAIN does not teach applying a linear directional force to a central bar member, but rather teaches swinging the handle in a clockwise direction as seen in Figure 1. Accordingly, the Applicant respectfully submits that amended Independent Claim 1 is not anticipated by MAIN under 35 USC § 102(b) and respectfully requests the withdrawal of the Examiner's rejection of Independent Claim 1.

The Examiner acknowledged in the telephone interview that newly amended Claim 1 overcomes the anticipation by MAIN.

Similarly, TAYLOR does not disclose the adaption of a tool for use in a confined or hard-to-reach area or environment. Instead, the tool in TAYLOR requires that the workpiece (tire rim) be unobstructed and easily accessible to the user. Further, although TAYLOR may teach a tool having two separate arms which share the same pivot point, when in use, the arms do not pivot or move apart from one another but instead remain stationary so as to anchor the tool to the workpiece. As in MAIN, the very purpose of the invention in TAYLOR is to provide mechanical advantage through the use of separate pivot points (8, 9) distanced from one another to create a camming effect. Further, TAYLOR does not teach applying a linear directional force to a central bar member, but rather teaches swinging the handle in a clockwise direction to create a rotational force as seen in Figure 2.

Nor does TAYLOR disclose any of the limitations of cancelled Claims 4, 5 or 8.

Accordingly, newly amended Independent Claim 1 has been amended to add the limitation of cancelled dependent Claim 4, and newly added Independent Claims 10 and 11 the limitations of cancelled Claim 5 and 8, respectively. Accordingly, the Applicant respectfully submits that Independent Claims 1, 10 and 11 are not anticipated by TAYLOR under 35 USC § 102(b) and respectfully requests the withdrawal of the Examiner's rejection of Independent Claim 1 and allowance of Claims 1, 10, and 11. Finally, newly added Independent Claim 12 is directed to a method having the limitation "providing an engagement arm configured for allowing the arm to pass under the mechanisms of the enclosure..." Accordingly, for the same reasons as set forth above, it is also allowable.

Claims 5 and 8 are dependent claims with respect to Independent Claim 1. Therefore, based upon the current amendment to Independent Claim 1, the Applicant submits that Claims 5 and 8 are presently in allowable form and respectfully requests the withdrawal of the Examiner's rejections.

Claim Rejections Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected dependent Claim 9 under 35 USC § 103(a) as unpatentable over MAIN or TAYLOR in light of U.S. Patent No. 886,170 issuing to Avansino ("AVANSINO"). Claim 9 has been cancelled.

CONCLUSION

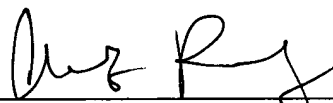
Claims 1, 5, 8, and 10-12 are currently pending. In view of the foregoing amendments and remarks, Applicant respectfully submits that all of the pending claims are in condition for immediate allowance. Applicant respectfully requests reconsideration of the application and allowance of the pending claims.

If the Examiner feels for any reason that direct contact with the Applicant's attorney will advance the prosecution of this case to finality, the Examiner is invited to contact the undersigned.

Respectfully submitted,

HIGGS, FLETCHER & MACK LLP
Attorneys for Applicant

Dated: September 15, 2004



Charles F. Reidelbach, Jr., Esq.
Registration No. 36,649

401 West A Street
Suite 2600
San Diego, CA 92101
Telephone: 619-236-1551
Facsimile: 619-696-1410
E-Mail: reidelbach@higgslaw.com